

REMARKS

Claims 9 and 11-17 are pending in the application. Claims 9 and 12-17 are rejected. Claim 11 is allowed. Applicant has amended claims 9, 11 and 13-17. Claims 10 and 12 have been cancelled.

Claim Rejections - 35 U.S.C. §112

Claim 17 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for particularly failing to point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is traversed for at least the following reasons.

The Examiner notes that claim 17 recites the limitation “said groove-like part” and finds that there is insufficient antecedent basis for this limitation in the claim. Applicant has amended claim 17 to again depend from claim 9. Proper antecedent basis is clearly provided.

Claim Rejections - 35 U.S.C. § 102

Claims 12, 13 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Petersen (EP 0 767 116 A2). This rejection should be traversed for at least the following reasons.

The Examiner has repeated the text of his rejections of claims 12 and 13 from the Office Action dated October 1, 2003 and in the Office Action dated September 30, 2003. Thus, nothing new has been added to the text of the rejection.

As to claim 12, the rejection is moot in view of the cancellation of the claim.

With regard to claims 13 and 17, Applicants respectfully note that the fundamental principle of law applied to any rejection of anticipation that:

“a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).”

This basic principle must be followed by the Examiner in rejecting claims, as prescribed by MPEP § 2131. Clearly, the Examiner has not complied with this requirement in formulating his rejection of claims 12, 13 and 17 as being anticipated by Petersen.

In response to Applicant's argument for patentability, specifically that Petersen does not teach the cover layer extending to the radial surface, the Examiner asserts that this is a matter of "arbitrary interpretation." Specifically, the Examiner asserts that the boss portion tapers and transitions into the radial surface. One of ordinary skill in viewing Figure 1 of Petersen would understand that the Examiner's position clearly is in error.

First, there is no basis for "arbitrary interpretation:"

- Claim 13 **expressly** requires a step of forming a cover layer "on the surface of the metal wire, covering one end thereof on the inner layer part of a boss part of the disc to form an outer layer of the boss part extending to said radial surface, and forming a protrusion."

The claim language specifies that the coating goes beyond the wire surface and is disposed over the boss part.

In Pedersen, as is clear from the figure, the wire coating necessarily must end at the rim 3a. The wire coating does not and cannot extend to the radial surface. Moreover, the specification at column 3, line 38 makes it absolutely clear that "the wire coating is preferably at each of the ends finished with an annular rim 3a." This teaching is that the wire coating must stop at the rim 3a and does not come near the boss or radial portion. No arbitrary interpretation is involved at all. This is a patently clear structural difference.

Moreover, according to the invention defined by Claim 13, there is a protrusion which is a portion of the cover layer. However, in Pedersen, there is an annular rim which is divided from the cover layer. Thus, the constitution of the invention is entirely different from that of Pedersen.

The Examiner takes the further position that this structural limitation should be given no weight since the claims are method claims. However, this particular structure is extremely

important in defining how far the wire coating may go. In Pedersen the coating goes to the rim 3a, and is limited to the linear surface of the wire. In the present invention, it goes over the linear portion of the wire and the curved surface of the boss. As would be clear to one skilled in the art, there are significant ramifications to the method if the coating only goes along the wire and does not travel up the boss or radial portion. The manufacturing process is much easier than that of the present invention. Problems with transitioning from the wire to the boss are not encountered in Pedersen. The applicator is uniform, and coating simply stops at rim 3a.

With regard to claim 13, the cover layer formed of a synthetic resin is formed on the surface of the metal wire covering one end thereof on the inner layer part of the boss part of a disc to form an outer layer of the boss part extending to the radial surface. Further, there is formed a protrusion corresponding to a depression on one end of the cover layer. Clearly, no such method or teaching appears in Petersen where again it is clear that the coating must stop at the groove and shall not continue to any boss or radial structure. The Examiner is using his own ingenuity and hindsight to change the clearest teaching of Petersen into one that would lead into the present invention.

Claim Rejections - 35 U.S.C. § 103

Claims 9 and 14-16 are rejected as being unpatentable over Petersen (EP 0 767 116 A2) in view of Winkler et al (4,373,113). This rejection is traversed for at least the following reasons.

The distinction of the present invention over Pedersen in view of Winkler was fully asserted in the previous Amendment and clearly supports patentability. In sum, Pedersen does not teach forming a cover layer and a groove like part that exposes the metal wire, and then molding a disc over the groove like part. In an opposite fashion, Pedersen forms a rim 3a, that is designed to enter a groove or socket 2a on the disk 2.

In the invention as now defined by Claim 9, a protrusion is formed in the substantially central part of each disc, but both in Pedersen and in Winkler, a protrusion isn't formed in the substantially central part of each disc (see Fig. 2B). Thus, the constitution of the invention is entirely different from that of Pedersen.

Winkler does not remedy the deficiencies of Petersen since it is in a different art and does not teach how or why one would modify Pedersen to have an opposite structure, that is one where the coating has a groove and a disk is attached. Clearly, Winkler does not teach a protrusion in the center of the disc. The dependent claims 14-16 would derive their patentability from claim 9.

Finally, Applicant again wishes to note that the claimed step in claim 9 is to mold the disc and cause the first synthetic resin to flow into the groove-like part to form a protrusion on the disc to fixedly mount it on the cable. This is completely contrary to the method used in Petersen where there is no flow of any resin into the groove that appears in the Petersen structure. This is a process completely opposite to and in a direction different that taught by Petersen.

Continuous Molding

As to all the claims, Applicant notes that the Examiner states that the Applicant relies on a feature that is not claimed in making his argument, namely “continuous molding”. This feature has been added to all the remaining claims that states that the invention is a process of “continually producing” a disc cable. Clearly, this feature is not seen in the prior art references.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. § 1.111
Application No. 09/842,634

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Respectfully submitted,

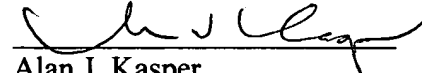
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